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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/625,946

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Andrew S. Van Luchene

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WALKER DIGITAL MANAGEMENT, LLC
2 HIGH RIDGE PARK
STAMFORD, CT 06905

EXAMINER

HAMILTON, MATTHEW L

ART UNIT

PAPER NUMBER

3688

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/625,946	Applicant(s) VAN LUCHENE ET AL.	
	Examiner MATTHEW L. HAMILTON	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/1/04, 7/7/04 and 7/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the initial filing filed on 23 July 2003.
2. Claims 1-20 are currently pending and have been examined.
3. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Inventorship

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Information Disclosure Statement

5. The Information Disclosure Statements filed on 01 July 2004, 07 July 2004 and 12 July 2004 have been considered. An initialed copy of each Form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-6, 8-16 and 18-19 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-7, 10-17 and 20 rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. US Patent 6,119,099.

Claim 1:

As per claim 1, **Walker** teaches a method comprising:
receiving information for a transaction (column 6, line 66 to column 7, line 6).
calculating an amount of change due in the transaction (column 1, lines 21-23).
determining a pool which includes one or more possible supplemental products (column 5, lines 57-67).
and providing an offer for (a) a coupon redeemable for at least one supplemental product from the pool in exchange for (b) the amount of change due in the transaction (column 10, lines 3-7 and column 9, lines 60-67).

Claim 2:

As per claim 2, **Walker** teaches the method of claim 1 as described above and further teaches *further comprising: selecting the at least one supplemental product* (column 6, lines 31-32).

Claim 3:

As per claim 3, **Walker** teaches the method of claim 2 as described above and further teaches *in which the step of selecting comprises:*
selecting all of the possible supplemental products of the pool, whereby the at least one supplemental product includes all of the possible supplemental products of the pool (column 8, line 66 to column 9, line 4).

Claim 4:

As per claim 4, **Walker** teaches the method of claim 2 as described above and further teaches *in which the step of selecting comprises:*
selecting the at least one supplemental product on a transaction history of a customer (column 7, lines 41-50).

Claim 5:

As per claim 5, **Walker** teaches the method of claim 2 as described above and further teaches *in which the step of selecting comprises:*
selecting the at least one supplemental product based on the amount of change due (column 5, lines 57-58 and column 6, lines 31-32).

Claim 6:

As per claim 6, **Walker** teaches the method of claim 1 as described above and further teaches *further comprising:*
receiving an acceptance of the offer (column 7, lines 26-27).
providing the coupon in exchange for the amount of change due in the transaction (column 10, lines 3-7 and column 9, lines 60-67).

Claim 7:

As per claim 7, **Walker** teaches the method of claim 1 as described above and further teaches *in which the step of providing an offer comprises:*
displaying the offer on a monitor viewable by a customer (column 12, lines 20-23).

Claim 10:

As per claim 10, **Walker** teaches a method comprising:
receiving information for a transaction (column 6, line 66 to column 7, line 6).
calculating an amount of change due in the transaction (column 1, lines 21-23).
determining a pool which includes one or more possible supplemental products (column 5, lines 57-67).
and providing an offer for (a) a coupon redeemable for at least one supplemental from the pool (column 9, lines 60-67 and column 10, lines 3-7), *and (b) another product in exchange for* (column 3, lines 26-32) *(c) the amount of change due in the transaction* (column 6, lines 31-32).

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Claim 11:

As per claim 11, **Walker** teaches a method comprising:

receiving information for a transaction (column 6, line 66 to column 7, line 6).

determining a pool which includes one or more possible supplemental products (column 5, lines 57-67).

determining a price of a coupon redeemable for at least one supplemental product from the pool (column 6, lines 60-67 and column 10, lines 3-7).

and providing an offer for (a) the coupon in exchange for (b) the determined price (column 6, lines 60-67 and column 10, lines 3-7).

Claim 12:

As per claim 12, **Walker** teaches the method of claim 11 as described above and further teaches *further comprising:*

selecting the at least one supplemental product (column 6, lines 31-32).

Claim 13:

As per claim 13, **Walker** teaches the method of claim 12 as described above and further teaches *in which the step of selecting comprises:*

selecting all of the possible supplemental products of the pool, whereby the at least one supplemental product includes all of the possible supplemental products of the pool (column 8, line 66 to column 9, line 4).

Claim 14:

As per claim 14, **Walker** teaches the method of claim 12 as described above and further teaches *in which the step of selecting comprises:*

selecting the at least one supplemental product based on a transaction history of a customer (column 7, lines 41-50).

Claim 15:

As per claim 15, **Walker** teaches the method of claim 12 as described above and further teaches *in which the step of selecting comprises:*
selecting the at least one supplemental product based on the amount of change due (column 5, lines 57-58 and column 6, lines 31-32).

Claim 16:

As per claim 16, **Walker** teaches the method of claim 11 as described above and further teaches *further comprising:*
receiving an acceptance offer (column 7, lines 26-27).
and providing the coupon in exchange for the determined price (column 10, lines 3-7 and column 9, lines 60-67).

Claim 17:

As per claim 17, **Walker** teaches the method of claim 11 as described above and further teaches *in which the step of providing an offer comprises:*
displaying the offer on a monitor viewable by a customer (column 12, lines 20-23).

Claim 20:

As per claim 20, **Walker** teaches the method of claim 11 as described above and further teaches *further comprising:*
printing the coupon (column 10, lines 10-12).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8-9 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. US Patent 6,119,099 in view of Dejaeger et al. US Patent 6,456,981 B1.

Claim 8:

As per claim 8, **Walker** teaches the method of claim 1 as described above and further teaches *further comprising:*

for at least one of the at least one supplemental product for which the coupon is redeemable (column 10, lines 4-9) but does not teach *displaying an advertisement*. However, **Dejaeger** teaches a method and apparatus for displaying a customized advertising message with a retail terminal in column 1, lines 19-21 and further teaches, *"In addition to facilitating the customer's operation of the consumer interactive terminal 20, the display monitor may be utilized to display an advertisement..."* (column 5, lines 45-47) and *"Moreover, retailers have placed electronic terminals in various locations throughout the store which display video and/or audio advertising messages in order to attract the attention of the customer."* (column 1, lines 58-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Walker to display an advertisement. One would have been motivated to add an advertisement in order to entice the customer to shop.

Claim 9:

As per claim 9, **Walker** and **Dejaeger** teach the method of claim 8 as described above and **Walker** further teaches *further comprising:*
receiving a signal indicating a product that a customer desires to purchase (column 2, lines 39-45).

Walker and **Dejaeger** do not teach *and in which the step of displaying an advertisement is performed in response to receiving the signal*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Walker to display an advertisement in response to signal. For example, an advertisement or advertisements can be displayed on a monitor at a point of sale before, in between or after scanning of products or anytime the consumer decides to purchase an item.

Claim 18:

As per claim 18, **Walker** teaches the method of claim 11 as described above and further teaches *further comprising:*
for at least one of the at least supplemental products for which the coupon is redeemable (column 10, lines 4-9) but does not teach *displaying an advertisement*. However, **Dejaeger** teaches a method and apparatus for displaying a customized advertising message with a retail terminal in column 1, lines 19-21 and further teaches, *"In addition to facilitating the customer's operation of the consumer interactive terminal 20, the display monitor may be utilized to display an advertisement..."* (column 5, lines 45-47) and *"Moreover, retailers have placed electronic terminals in various locations throughout the store which display video and/or audio advertising messages in order to attract the attention of the customer."* (column 1, lines 58-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Walker to display an advertisement. One would have been motivated to add an advertisement in order to entice the customer to shop.

Claim 19:

As per claim 19, **Walker** and **Dejaeger** teaches the method of claim 18 as described above and **Walker** further teaches *further comprising:*

receiving a signal indicating a product that a customer desires to purchase (column 2, lines 39-45).

Walker and **Dejaeger** do not teach *and in which the step of displaying an advertisement is performed in response to receiving the signal*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Walker to display an advertisement in response to signal. For example, an

advertisement or advertisements can be displayed on a monitor at a point of sale before, in between or after scanning of products or anytime the consumer decides to purchase an item.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW L. HAMILTON whose telephone number is (571)270-1837. The examiner can normally be reached on Monday-Friday 7:30a.m-5p.m EST alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571) 272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLH
Examiner, Art Unit 3688
June 11, 2008

/James W Myhre/
Supervisory Patent Examiner, Art Unit 3688

